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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,852	11/07/2001	Alan M. Kinnersley	7224-65	8960

7590

01/14/2005

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application N .

10/006,852

Applicant(s)

KINNERSLEY ET AL.

Examiner

Cynthia Collins

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-15, 19, 20, 22, 23, 26-28, 31, 32, 34, 35, 37, 38 and 40.

Claim(s) withdrawn from consideration: 16-18, 21, 24, 25, 29 and 30.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: note the attached interview summary of 11/04.

*Cynthia Collins* 11/12/05

Continuation of 2. NOTE: the proposed amendments raise new issues that would require further consideration and search under 35 USC 112 and 35 USC 102 or 103 with respect to limitations directed to a "stunted" phenotype, as this limitation has not previously been searched or considered; the proposed amendments raise new issues that would require further consideration under 35 USC 102 or 103 with respect to polynucleotides encoding plant GAD enzymes that comprise an amino acid sequence having at least 70% identity to SEQ ID NO:2, and with respect to the range of phenotypic characteristics exhibited by the transformed plants, as the proposed amendments change the scope of the claims.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the proposed amendment would overcome the outstanding objection to claims 8, 12, 28, 35 and 40; the proposed amendment would overcome the outstanding rejection of claims 31-32 and 34-40 under 35 U.S.C. 102(b) as being anticipated by Baum et al. (EMBO J., 17 June 1996, Vol. 15, No. 12, pages 2988-2996, Applicant's IDS) the proposed amendment would overcome the outstanding rejection of claims 1-15, 19-20, 22-23 and 26-27 under 35 U.S.C. 103(a) as being unpatentable over Baum et al. (EMBO J., 17 June 1996, Vol. 15, No. 12, pages 2988-2996, Applicant's IDS) in view of McKenzie et al. (Plant Physiology, March 1998, Vol. 116, No.3, pages 969-977).

Continuation of 5. does NOT place the application in condition for allowance because: polynucleotides encoding plant GAD enzymes that comprise an amino acid sequence having at least 70% identity to SEQ ID NO:2 are not described or enabled, as the percent identity between SEQ ID NO:2 and the eight other plant GAD amino acid sequences disclosed (Arabidopsis thaliana GADs 2-5, tobacco NtGADs 1-2, petunia GAD, tomato GAD) is between 74.5% and 85.3% according to the declaration filed April 23, 2004.